

Arguments/Remarks

Claims 1-26 are pending in the patent application and new Claims 27-38 have been added. Before addressing the restriction requirement, Applicants would like to draw the Examiner's attention to the following facts and clarifications:

(1) The current application claims priority to US Provisional Application No. 60/560,186 filed on April 7, 2004. A Non-provisional Patent application (US Serial No. 11/099,941) was filed on April 6, 2005 which claimed priority to the same US Provisional application. US Serial No. 11/099,941 resulted in a granted patent on September 2, 2008: US Patent No. 7,419,975. The granted claims are directed to those compounds where U is a bicyclic saturated or unsaturated ring system of Formula III. None of the claims are directed to compounds where U is a structure of Formula II or V. No pending applications remain from this specific lineage in the USPTO.

(2) Claims 2 and 3 of the published US Patent No. 7,419,975 incorrectly contain structures of Formula (II) which was an error by the USPTO. A certificate of correction was filed and receipt acknowledged by the USPTO on May 24, 2010.

(3) In the description of the ELISA and Cell Proliferation assays on pages 113 and 114 of the current application, the following statements are made in the respective assays:

"The IC₅₀ values of compounds listed in Table 1 in the described ELISA assays ranged from 0.005 – 10 μ M."

"The IC₅₀ values of compounds listed in Table 1 in the described cell assays ranged from 0.005 – 50 μ M."

There is no specific label for Table 1 in the specification. Applicants would like to clarify that the reference to Table 1 refers to the compounds listed in the table before the statement splitting the table into two parts between Examples 78 and 79 on page 86 of the specification which states "Additional compounds within the scope of Formula I include." In addition, Applicants would like to point out that the MS ESI data listed for Examples 79 through and including Example 194 are calculated values.

Amendments to the Claims

Claim 25 has been cancelled as being directed to subject matter outside the scope of current new Claim 27. Applicants reserve the right to pursue the deleted subject matter in a continuation application. Claims 24 and 26 have been amended to remove subject matter

that is either claimed in granted US Patent No. 7,419,975 or outside the scope of current new Claim 27 and to add structures for the remaining named compounds listed in the claims.

Support for new Claims 27-38 may be found in the specification at the corresponding locations.

Claim 27 – paragraphs [0059], [0060], [0061], [0063], [0064], [0065], [0067], [0068], [0070], [0071], [0072], [0073], and [0074].

Claim 28 – paragraph [0091]

Claim 29 – paragraphs [0060] and [0061]

Claim 30 – Ex. 7, 139, 138, 137, 136, 133, 127, 124, 123, 80, 52, 51, 50, 49, and 40

Claim 31 – paragraphs [0063], [0064], and [0065].

Claim 32 – Ex. 78, 135, 132, 122, 121, 120, 119, 118, 117, 116, 115, 114, 113, 112, 110, 109, 108, 107, 103, 102, 101, 100, 42, and 41.

Claim 33 – paragraphs [0067] and [0068].

Claim 34 – Ex. 45, 98, 97, 96, 95, 94, 92, 89, 88, 87, 86, 85, 84, 83 and 44.

Claim 35 – paragraphs [0070] and [0071]

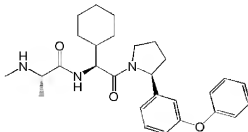
Claim 36 – Ex. 79, 77, and 47.

Claim 37 – paragraphs [0073] and [0074].

Claim 38 – Ex. 131, 130, 126, 125, and 81.

Restriction Requirement

Examiner has restricted each individual compound in Claim 24 which Applicants respectfully disagree with such narrow restrictions since many of the compounds have common cores and functional groups; therefore, it would not require an undue burden on the Examiner to conduct his search. In a phone conversation with the Examiner, it was agreed to provide structures for the compounds so that Examiner could see the commonality among the various structures. Applicants have provisionally elected the following compound (Example 45) upon which the Examiner can initiate his examination as a species election.



(S)-N-[(S)-1-Cyclohexyl-2-oxo-2-[(S)-2-(3-phenoxy-phenyl)-pyrrolidin-1-yl]-ethyl]-2-methylamino-propionamide.

Applicants respectfully request rejoinder of Claims 22 and 23 (directed to methods of treatment) upon the allowance of any compounds claims upon which these claims depend.

Should the Examiner have any questions, please contact the undersigned attorney.

Respectfully submitted,

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Date: 3 January 2011